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CARR & FERRELL LLP
2200 GENG ROAD
PALO ALTO, CA 94303

EXAMINER

VAUGHN, GREGORY J

ART UNIT

PAPER NUMBER

2178

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/636,418

Applicant(s)

AXE ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application History

1. This action is responsive to the application amendment, filed on 9/20/2004.
2. Applicant has added new claims 34 and 35.
3. Claims 1-35 are pending in the case, claims 1, 2, 9, 12, 14, 15, 16, 24 and 29 are independent claims.

Claim Rejections - 35 USC § 112

4. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains new subject matter, which was not described in the originally filled specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claim 34 recites: "*selection of one of the plurality of selectable objects occurred prior to the selection of one of the plurality of slots*" (amendment filed 9/20/04, page 11, lines 1-2 of claim 34). Applicant has directed the examiner to page 13, lines 5-21 of the originally filed specification, but support for the new limitation "*occurred prior to*" was not found.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

6. Claim 34 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. **Regarding Claim 34**, the method claimed in claim 34 is not embodied on a computer readable medium. Methods not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). See MPEP § 2106 (IV.1.a)

Furthermore, the method claimed in claim 34 is a non-descriptive data structure. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. See MPEP § 2106 (IV.1.b)

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

9. Claims 1-3, 6-9, 14-17, 23-30, 32 and 33 remain rejected under 35 U.S.C. 102(b) as being anticipated by Henson US Patent 6,167,383, filed 9/22/1998, patented 12/26/2000.
10. Claims 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Henson.
11. **Regarding independent claim 1**, Henson recites: *"The configurator is provided for configuring a computer system with options selected according to a prescribed user input"* (column 2, lines 65-67). Henson discloses in Figure 3A, an initialized configuration layout with a plurality of components and slots (shown at reference signs 75 and 77). Also shown in Figure 3A are selectable objects (shown as drop-down list boxes) where a selection can be made for

the designated slot. At reference sign 86 in Figure 3A, Henson discloses receiving a visual feedback indicating the validity of a selection (shown as *"This option is not compatible with ..."*). Henson also recites: *"The validation module provides validation of some form with respect to the customer built configuration"* (column 6, lines 34-36). Reference sign 76 of Figure 3A discloses the placement of the selected object (shown as *"Hard Drive"*). Henson also recites: *"the configurator 18 which are being driven by the database 24 are illustrated. In essence, the entire configurator 18 is being driven by the database. As mentioned, the configurator 18, shopping cart 20, and checkout 22 are each part of the commerce application 14 and prone to be driven by the database 24"* (column 5, lines 55-60), (compare *"inference engine"* to *"database"*). Henson further recites: *"Turning now to FIG. 2, a customer can access the online store 10 using any suitable computer equipment 40, via the Internet 42"* (column 5, line 66 to column 6, line 1) where the online store contains the inference engine (shown as *"Database"* at reference sign 24 in Figure 1). Henson also recites: *"Turning now to FIG. 3 (3A, 3B, and 3C), from a system configuration options screen 70, a customer of the online store 10 can build a customer configured machine by selecting from options listed on the configuration screen 70. The pricing option module 28 includes an update price function. The update price function causes the price displayed on the configuration screen to reflect any changes made to the system options"* (column 6, lines 18-25).

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12. **Regarding independent claim 2**, Henson recites: *"The configurator is provided for configuring a computer system with options selected according to a prescribed user input"* (column 2, lines 65-67). Henson discloses in Figure 3A, an initialized configuration layout with a plurality of components and slots (shown at reference signs 75 and 77). Also shown in Figure 3A are selectable objects (shown as drop-down list boxes) where a selection can be made for the designated slot. Henson also recites: *"The database 24 provides information to the configurator 18"* (column 4, lines 64-65) and *"The present online store takes into account that some choices are not as right as others. Thus the configurator of the present online store has been made smarter"* (column 5, lines 38-40). Reference sign 76 of Figure 3A discloses the placement of the selected object (shown as *"Hard Drive"*). Henson also recites: *"the configurator 18 which are being driven by the database 24 are illustrated. In essence, the entire configurator 18 is being driven by the database. As mentioned, the configurator 18, shopping cart 20, and checkout 22 are each part of the commerce application 14 and prone to be driven by the database 24"* (column 5, lines 55-60), (compare *"inference engine"* to *"database"*). Henson further recites: *"Turning now to FIG. 2, a customer can access the online store 10 using any suitable computer equipment 40, via the Internet 42"* (column 5, line 66 to column 6, line 1) where the online store contains the inference engine (shown as *"Database"* at reference sign 24 in Figure 1). Henson also recites: *"Turning now to FIG. 3 (3A, 3B, and 3C), from a system configuration options screen 70, a customer of the online store 10*

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can build a customer configured machine by selecting from options listed on the configuration screen 70. The pricing option module 28 includes an update price function. The update price function causes the price displayed on the configuration screen to reflect any changes made to the system options" (column 6, lines 18-25). Finally, Henson discloses storing the new set of restraints, as shown by the "Save My Cart" button shown in Figure 6, at reference sign 106.

13. **Regarding dependent claim 3**, Henson recites: *"The warning icon and associated messaging are made present in the configurator once an update/refresh of the web page has been requested, for example, through clicking on any of a number of store navigation or action buttons"* (column 6, lines 51-55), (compare "transmitting" to "update request").
14. **Regarding dependent claim 6**, Henson recites: *"the configurator 18 which are being driven by the database 24 are illustrated. In essence, the entire configurator 18 is being driven by the database. As mentioned, the configurator 18, shopping cart 20, and checkout 22 are each part of the commerce application 14 and prone to be driven by the database 24"* (column 5, lines 55-60), (compare "inference engine" to "database").
15. **Regarding dependent claims 7 and 8**, Henson recites: *"The disclosures herein relate generally to build to order computer systems, and more particularly, to an online store user interface for enabling custom configuration, pricing, and ordering of a computer system via the Internet"*

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(column 12, lines 18-21) and *"Display 42 is used for displaying the various pages of the online store while a customer is using the online store"* (column 6, lines 3-4).

16. **Regarding independent claim 9**, Henson recites: *"The configurator is provided for configuring a computer system with options selected according to a prescribed user input"* (column 2, lines 65-67). Henson discloses in Figure 3A, an initialized configuration layout interface with a plurality of components and slots (shown at reference signs 75 and 77). Also shown in Figure 3A are selectable objects (shown as drop-down list boxes) where a selection can be made for the designated slot. Henson further recites: *"According to one embodiment, a web-based online store having a user interface for enabling a custom configuration of a computer system according to an identification of a user belonging to a prescribed customer set includes a configurator, a cart, a checkout, and a database. The configurator is provided for configuring a computer system with options selected according to a prescribed user input"* (column 2, lines 61-65).

17. **Regarding independent claim 14**, the claim is directed toward a computer program for the method of claim 1, and is rejected with the same rational.

18. **Regarding independent claim 15**, the claim is directed toward a computer program for the method of claim 2, and is rejected with the same rational.

19. **Regarding independent claim 16**, Henson discloses a plurality of objects and slots as shown in Figure 3A. Henson further recites: *"With reference again to the configurator, the view module 30 includes an "all option" configurator view. That is, an ability to change from a standard view 70 (as shown in FIG. 3) to an "all option" view 90 (as shown in FIG. 5) is provided. The standard view of the online configurator is where system options 77 are presented via "drop-down" selection boxes and only the currently selected option is displayed. The standard view is preferably the default display, i.e., displayed without a shopper action"* (column 9, lines 9-17), (compare "predetermined" to "default"). Henson further recites: *"Turning now to FIG. 2, a customer can access the online store 10 using any suitable computer equipment 40, via the Internet 42"* (column 5, line 66 to column 6, line 1) where the online store contains the inference engine (shown as "Database" at reference sign 24 in Figure 1). Henson also recites: *"Turning now to FIG. 3 (3A, 3B, and 3C), from a system configuration options screen 70, a customer of the online store 10 can build a customer configured machine by selecting from options listed on the configuration screen 70. The pricing option module 28 includes an update price function. The update price function causes the price displayed on the configuration screen to reflect any changes made to the system options"* (column 6, lines 18-25). Henson further discloses in Figure 3A, an indication that the selected object is not compatible with the current configuration at reference sign 86, and an indication that the selected object is compatible with the selected configuration at reference sign 77.

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20. **Regarding dependent claim 17**, Henson recites: *"Option details 76 provide an ability to link from the configurator to more specific detailed information about the system selection options presented. Links are made possible at each point where a system option selection was possible to aid in the choosing of the correct option from displayed alternatives"* (column 7, lines 48-53), (compare *"finite number of product configuration layouts"* to *"each point where a system option selection was possible"*).
21. **Regarding dependent claim 23**, Henson discloses in Figure 3A, at reference sign 70, a configuration layout which represents the physical layout of the product (shown as an image in the upper left hand corner).
22. **Regarding independent claim 24**, Henson discloses a product configuration layout with a plurality of objects and slots displayed within a graphical user interface as shown in Figure 3A. Henson also recites: *"Turning now to FIG. 3 (3A, 3B, and 3C), from a system configuration options screen 70, a customer of the online store 10 can build a customer configured machine by selecting from options listed on the configuration screen 70"* (column 6, lines 18-21). Henson further discloses in Figure 3A, an indication that the selected object is not compatible with the current configuration at reference sign 86, and an indication that the selected object is compatible with the selected configuration at reference sign 77.

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23. **Regarding dependent claim 25**, Henson discloses in Figure 3A, at reference sign 70, a configuration layout with the plurality of selectable objects.

24. **Regarding dependent claim 26**, Henson recites: *"With reference again to the configurator, the view module 30 includes an "all option" configurator view. That is, an ability to change from a standard view 70 (as shown in FIG. 3) to an "all option" view 90 (as shown in FIG. 5) is provided. The standard view of the online configurator is where system options 77 are presented via "drop-down" selection boxes and only the currently selected option is displayed. The standard view is preferably the default display, i.e., displayed without a shopper action" (column 9, lines 9-17), (compare "predetermined" to "default").*

25. **Regarding dependent claim 27**, Henson discloses in Figure 3A, at reference sign 70, a configuration layout with the plurality of slots.

26. **Regarding dependent claim 28**, Henson discloses in Figure 3A, at reference sign 70, a configuration layout which represents the physical layout of the product (shown as a picture in the upper left hand corner).

27. **Regarding independent claim 29**, Henson recites: *"At the on-line store, a customer can select one or more products that the customer is interested in. Upon selection of a particular product, the on-line store presents the customer with the ability to go to the product information for the particular*

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product, customize the product, price the customized product, purchase the product" (column 4, lines 41-46). Henson discloses a plurality of objects and slots as shown in Figure 3A. Henson also recites: "*Turning now to FIG. 3 (3A, 3B, and 3C), from a system configuration options screen 70, a customer of the online store 10 can build a customer configured machine by selecting from options listed on the configuration screen 70. The pricing option module 28 includes an update price function. The update price function causes the price displayed on the configuration screen to reflect any changes made to the system options"* (column 6, lines 18-25). Henson discloses in Figure 3A, at reference sign 75 a subset of the configuration rules, in response to the selection of an object (as shown at reference sign 77).

28. **Regarding dependent claim 30**, Henson discloses in Figure 3A, at reference sign 75, a subset of the configuration rules, in response to the selection of an object (as shown at reference sign 77).

29. **Regarding dependent claim 32**, Henson recites: "*Option details 76 provide an ability to link from the configurator to more specific detailed information about the system selection options presented. Links are made possible at each point where a system option selection was possible to aid in the choosing of the correct option from displayed alternatives"* (column 7, lines 48-53), (compare "*finite number of product configuration layouts"* to "*each point where a system option selection was possible"*).

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30. **Regarding dependent claim 33**, Henson discloses in Figure 3B, at reference sign 86, the validity of a selected object that has been affected by the selection of another object.
31. **Regarding dependent claim 34**, Henson discloses the selection of one of a plurality of selectable objects and the selection of one of the plurality of slots as described above. Henson discloses in Figure 3A, at reference sign 77 the selection of a selectable object (shown as a drop down selectable list, where the value selected is "96MB SDRAM") prior to the selection of one of the plurality of other slots (for instance the "Video Card" slot).

Claim Rejections - 35 USC § 103

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

33. Claims 4, 5, 11-13 and 18-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Henson.

34. **Regarding claims 4, 5, 11, 12 and 18,** Henson discloses visually configuring a product, including the looking up and storing of product constraints, as described above. Henson fails to explicitly describe the use of a *“forward looking rules table”*. However, Henson discloses a *“Database”* (shown in Figure 1 at reference sign 24), wherein data in a database is represented as tables. Henson recites: *“The database 24 provides information to the configurator 18”* (column 4, lines 64-65) and *“The present online store takes into account that some choices are not as right as others. Thus the configurator of the present online store has been made smarter”* (column 5, lines 38-40) and *“The present online store takes into account that some choices are not as right as others. Thus the configurator of the present online store has been made smarter”* (column 5, lines 38-40). Reference sign 76 of Figure 3A discloses the placement of the selected object (shown as

"Hard Drive"). Henson also recites: *"the configurator 18 which are being driven by the database 24 are illustrated. In essence, the entire configurator 18 is being driven by the database. As mentioned, the configurator 18, shopping cart 20, and checkout 22 are each part of the commerce application 14 and prone to be driven by the database 24"* (column 5, lines 55-60).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to describe the database feature of Henson as having a forward looking rules tables because the data base provides *"the database is provided for dynamically supplying configuration options to the configurator"* (Henson, column 3, lines 9-10).

35. **Regarding claims 12, 19 and 20**, Henson discloses visually configuring a product from a plurality of selectable components, with a user interface for selecting components and slots, and intelligence for determining object placement validity; and an online store for storing the rules and constraints for object placement as described above. Henson fails to explicitly describe a client device or a remote host device. However, Henson discloses in Figure 2, a client (at reference sign 40) connected remotely via the Internet (at reference sign 38) to a remote host (at reference sign 10, described as *"On-Line Store"*).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to describe the system configuration of Henson as a client-host type of configuration to provide *"an online store user interface for*

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enabling custom configuration, pricing, and ordering of a computer system via the Internet" (Henson, column 1, lines 19-21).

36. **Regarding dependent claim 13**, Henson recites: "*a web-based online store having a user interface for enabling a custom configuration*" (column 2, lines 61-62). Henson also discloses in Figure 2 a network service (at reference sign 38, described as "*Internet*").

37. Claims 10, 21, 22 and 31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of King et al. US Patent 6,161,114 (filed 4/14/1999, patented 12/12/2000). "*King et al.*" is hereafter referred to as "*King*".

38. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of King.

39. **Regarding dependent claims 10, 21, 22 and 31**, Henson discloses visually configuring a product from a plurality of selectable components with a user interface and a conflict displayer, as described above. Henson fails to disclose drag and drop functionality. King discloses the use of drag and drop functionality. King recites: "*In some embodiments, powerful content processing capabilities make assembly of content from a wide variety of resources (another disk, over a network, from the Internet, for example) as simple as executing a drag and drop action*" (column 6, lines 8-11).

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Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to use the drag and drop teachings of King to enhance the object selection function of Henson to allow users the ability to *"improve document production"* (King, Column 6, line 7).

40. **Regarding claim 35**, the claim is directed toward method for the system of claim 10 and is rejected using the same rationale.

Respons to Arguments

41. Applicant's arguments filed 9/20/2004 have been fully considered but they are not persuasive.
42. **Regarding claim 1**, applicant recites: "*The Applicants, therefore, request that the Examiner specifically point out teachings within Henson that teach *(d) receiving a placement of the selected object*" (amendment of 9/20/2004, page 13, lines 15-17). Applicant is directed to the rejection of claim 1, as restated above. Henson clearly shows the user receiving placement of the selected object in Figure 3A at reference sign 76 (the selected and placed object is shown as "*Hard Drive*").
43. **Also, regarding claim 1**, the applicant recites: "*The Applicants are unable to identify any teaching within Henson that suggests that a user can "place" or "move" an item*" (amendment of 9/20/2004, page 14, lines 13-14). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*move an item*") is not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
44. **Also, regarding claim 1**, the applicant recites: "*Henson does not teach a "plurality of slots in which the selected object may be placed," as recited in*

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Claim 1" (amendment of 9/20/2004, page 14, lines 15-16). Applicant is directed to the rejection of claim 1, as restated above. Henson discloses in Figure 3A, an initialized configuration layout with a plurality of components and slots (shown at reference signs 75 and 77). Also shown in Figure 3A are selectable objects (shown as drop-down list boxes) where a selection can be made for the designated slot. The selected object (for example "96MB SDRAM" shown at reference sign 77) is placed in the slot as shown.

45. **Also, regarding claim 1**, the applicant recites: "*The Applicants, therefore request that the Examiner specifically point out teaching of (b) receiving a selection of one of the plurality of selectable objects, and of one of the plurality of slots in which the selected object may be placed*" (amendment of 9/20/2004, page 14, lines 18-21). Applicant is directed to the rejection of claim 1, as restated above. Also, further support for this rejection can be found in paragraphs 37 and 39 above.

46. **Regarding claim 2**, the applicant recites: "*Henson does not teach a plurality of slots in which the selected object may be placed, and receiving a placement of the selected object*" (amendment of 9/20/2004, page 15, lines 20-22). Applicant is directed to the rejection of claim 2, as restated above. Also, further support for this rejection can be found in paragraphs 37 and 39 above.

47. **Also, regarding claim 2**, the applicant recites: "*It is the position of the Applicants that the "Save My Cart" button illustrated in Figure 6 of Henson*

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does not teach storing a new set of constraints" (amendment of 9/20/2004, page 15, lines 26-28). Applicant is directed to the rejection of claim 2, as restated above. In further support of the rejection Henson discloses the "Save My Cart" in Figure 6 button and function as previously described. Also, in Figure 6, adjacent to the "Save My Cart" button is a description of the action related to that function, wherein it is written: *"Record your shopping for ordering later"*. Henson also discloses in Figure 1 at reference sign 20 "Cart" which is directly connected to the "Database" where the constraints related to the shopping session are stored.

48. **Also, regarding claim 2**, the applicant recites: *"The Applicants, therefore, request that the Examiner identify teaching that constraints are saved using the "Save My Cart" button"* (amendment of 9/20/2004, page 16, lines 6-8). Applicant is directed to the rejection of claim 2, as restated above. Also, further support for this rejection can be found in paragraph 42 above.

49. **Regarding claim 9**, the applicant recites: *"However, the specification as filed makes clear that "the user intelligence 140 performs the functions of sending data to the inference engine 170" (pg 10 lines 13-15) and that this communication is "from the client device 910 to the remote server 920" (page 17 line 21)"* (amendment of 9/20/2004, page 17, lines 15-18). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *"user intelligence 140 performs the functions of sending data to the*

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inference engine" and *"this communication is "from the client device 910 to the remote server 920"*) is not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

50. **Also, regarding claim 9**, the applicant recites: *"The Applicants request that the Examiner more specifically point out which aspects of the cited art teach each limitation of Claim 9"* (amendment of 9/20/2004, page 18, lines 3-4). Applicant is directed to the rejection of claim 9, as restated above. In further support of the rejection Henson recites: *"According to one embodiment, a web-based online store having a user interface for enabling a custom configuration of a computer system according to an identification of a user belonging to a prescribed customer set includes a configurator, a cart, a checkout, and a database. The configurator is provided for configuring a computer system with options selected according to a prescribed user input"* (column 2, lines 61-65). Henson discloses a user intelligence (described as *"user input"*) coupled to a user interface, a set of constraints (described as *"cart"*) received from a remote inference engine (described as *"database"*) and implementing the set of constraints (described as *"configurator is provided for configuring a computer system with options selected"*).

51. **Regarding claim 16**, the applicant recites: *"Henson does not teach a "slots in which the selected object may be placed," (Claim 1) and therefore*

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does not teach "indicat[ing] that the selected object cannot be placed in the selected slot (claim 16)" (amendment of 9/20/2004, page 19, lines 6-9).

Applicant is directed to the rejection of claim 16, as restated above. In further support of the rejection, see paragraphs 34-37 above.

52. **Also regarding claim 16**, the applicant recites: *"It is the Applicants' position that the teachings cited in Figure 3A do not teach "(c) causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot, if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules," as recited in Claim 16"* (amendment of 9/20/2004, page 19, lines 13-17). Applicant is directed to the rejection of claim 16, as restated above. In further support of the rejection, Henson discloses in Figure 3A, at reference sign 86, an indication that the selected object is not compatible with the current configuration (shown as a message displayed on the user interface, where the message states *"This option is not compatible with a Windows NT operating system. Please double-check your operating system selection"*).

53. **Also, regarding claim 16**, the applicant recites: *"FIGs. 3 and 6 of the specification, wherein indication is provided while a user is dragging a selected object toward a slot"* (amendment of 9/20/2004, page 19, lines 21-23). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *"dragging a selected object toward a slot"*) is not

recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

54. **Regarding claim 17**, the applicant recites: *"The Applicants, therefore, request that the Examiner clarify how "each point where a system option selection was possible" teaches a "finite number of product configuration layouts" (amendment of 9/20/2004, page 20, line 28 to page 21, line 2).* Applicant is directed to the rejection of claim 17, as restated above. Henson's statement: *"each point"* has been interpreted to mean *"all points"* and hence, a finite number of points.

55. **Regarding claim 23**, the applicant recites: *"There is no teaching within Henson that this is a representation of the physical order of these elements in the computer product being purchased"* (amendment of 9/20/2004, page 21, lines 15-17). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *"physical order"*) is not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

56. **Regarding claim 24**, the applicant recites: *"Henson does not teach a "a slot for placement of one of the plurality of objects" and "plurality of selectable objects for placement within the slot" (amendment of 9/20/2004, page 22,*

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lines 25-27). Applicant is directed to the rejection of claim 24, as restated above. In further support of the rejection, see the paragraphs 34-47 above.

57. **Regarding claim 29**, the applicant recites: "*Henson does not teach 'slots within which at least one of the plurality of objects may be placed,' and 'selecting a first of the plurality of objects for placement in a first of the one or more slots'*" (amendment of 9/20/2004, page 24, lines 24-27). Applicant is directed to the rejection of claim 29, as restated above, and to paragraphs 34-47 above.

58. **Regarding claims 4 and 5**, the applicant recites: "*The Applicants respectfully request that the Examiner provide support for the assumption that the use of forward-looking tables are obvious*" (amendment of 9/20/2004, page 27, lines 26-27). Applicant is directed to the rejection of claims 4 and 5, as restated above.

59. **Regarding claim 11**, the applicant recites: "*The Applicants, therefore, request that the Examiner specifically point out those sections of Henson that he believes teach these elements of Claim 11*" (amendment of 9/20/2004, page 28, lines 22-24). Applicant is directed to the rejection of claim 11, as restated above.

60. **Regarding claim 12**, the applicant recites: "*Applicants' position that the claimed arrangement, including a 'user intelligence' is not taught in Henson. The Applicants, therefore request that the Examiner specifically point out*

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teaching of this limitation within Henson" (amendment of 9/20/2004, page 30, lines 6-8). Applicant is directed to the rejection of claim 12, as restated above, and to paragraphs 34-47 above.

61. **Regarding claims 10, 21, 22 and 31**, the applicant recites: "*this motivation does not support the combination of art as suggested by the examiner under 35 U.S.C. 103(a)*" (amendment of 9/20/2004, page 32, lines 22-23). Applicant is directed to the rejection of claims 10, 21, 22 and 31, as restated above. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation suggested by the examiner "*to improve document production*" in response to the "*drag and drop*" limitation of the claims is meant to indicate that the combination of references would obviously improve the production of the relative system (in the case of King, a document system; in the case of Henson, a product configuration system).

Conclusion

62. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

63. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

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Gregory J. Vaughn
January 14, 2005


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER